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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,477	05/17/2001	Akira Sekine	H6810.0021/P021	2982

24998 7590 08/25/2004

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EXAMINER	
GAKH, YELENA G	

ART UNIT	PAPER NUMBER
1743	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/858,477	SEKINE ET AL.	
	Examiner	Art Unit	
	Yelena G. Gakh, Ph.D.	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) *19-38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18,39 and 40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *07/08/04* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The amendment filed on 06/22/04 is acknowledged. Claims 19-38 are cancelled without prejudice. Claims 1-18 and 39-40 are pending in the application.

Response to Amendment

2. Rejection of the pending claims under 35 U.S.C. 112, second paragraph is modified, and new objections and rejections are established in view of the amendment. Rejection over the prior art remains the same.

Claim Objections

3. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim recites the subject matter of the parent claim, since the parent claim already indicates that some of the controlled substances are categorized by a group control ID. Just one group control ID is recited for said controlled substances, which means that all controlled substances of the same group have the same control group ID.

Double Patenting

4. Claim 40 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim 40 recites the same subject matter as claim 1, since claim 1 recites that at least some of the controlled substances belong to the same group and are characterized by a group control ID.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 6 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Recitation of claim 6 regarding providing the data sets recited in claim 1 by an outsourcing company is not an active step of the method and is not enabled by the disclosure, since no routineer in the art can practice the method if the steps of the method should be performed by someone else. Claim 6 is enabled only for the outsourcing company, which contradicts the terms of 35 U.S.C. 112, first paragraph.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-18 and 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 12 and 39 recite, "providing a first data set containing substances". Such expression may assume a set that physically contains chemical compounds, which is not the case. The specification refers to 'a first data set [or *database*, which is more appropriate term] **of** compositions of said chemical materials', which is much clearer definition. It is further not clear, what does the expression, "at least some of said controlled substances are in the same group with respect to reporting requirements" refer to? What type of "reporting requirements"

is meant here? How are compounds grouped together according to these requirements? Are they grouped according to their toxicity? Or they should have some other common characteristics? In the third step it is not clear, which are these ratios? Are they the ratios of the controlled substances to each other? Are they the ratios of the controlled substances relative to non-controlled substances?

It is completely unclear, what "determining **a first quantity** of said controlled substances" might mean. What is the second quantity? Is this the quantity of all controlled compounds together? How can it be obtained from the first and second data sets, if the data sets provide only qualitative information on the compounds? This step needs clarification.

The last step is also unclear, since it is not apparent, as it was indicated above, which ratios are considered here, and what is the first quantity of the controlled compounds.

Claims 2, 8 and 14 are not clear and definite. What type of information about "said controlled substances" is meant here? "Information" is a very broad and indefinite term to be a limitation for the subject matter of the parent claims, since the parent claims also recite "information" about the controlled substances.

Claim 14 recites a limitation "said substance", which lacks an antecedent basis, since the parent claim recites "substances". Moreover, the parent claim recites two types of substances: substances comprising the chemical materials, and controlled substances. It is not clear, which substance is recited in claim 14?

In claims 3, 9 and 15 it is not clear, what "the source of the control" is, and therefore it is not clear, what is its control object code?

Claim 12 is not clear regarding its second step. What does the second data set comprise? The names of the controlled substances? Grouped controlled substances? Groups provided with group control IDs? Also, it is not clear, what is principle in forming the groups of controlled compounds? The language of the claim renders it unclear and indefinite.

Claims 39 and 40 repeat the same limitation twice. Thus, in claim 39 the second step comprises "grouping said at least some of said legally controlled substances, that belong to the same group, by a group control ID" and then, "wherein said group control ID is the same for said substances in the same group". The last phrase is a completely tautology of the first one, and does not add any information. The same is true for claim 40.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-18 and 39-40** are rejected under 35 U.S.C. 102(b) as being anticipated by Sturgeon et al. (US 5,664,112).

Sturgeon teaches a method of integrated Hazardous Materials Management (HMM), providing database for materials containing hazardous compounds and grouping controlled (hazardous) substances by Hazardous Materials Index. "The HMM grouping 21 monitors consumption of chemicals and chemical mixtures, using process definitions and using manual drawdown for non-process consumption. Process definitions cover all chemicals used as input materials for a given process. Process templates provide users with reusable process definitions and with process run parameters such as process run date and frequency of use. Chemical emissions, outfalls and by-product wastes are tracked as they arise by the HPM [Hazardous Permit Management] and HWM [Hazardous Waste Management] groupings 31 and 51. The HMM grouping 21 can generate in-house chemical transfer and usage reports and mass balance reports" (col. 12, lines 21-31). Process templates intrinsically provide ratio of discharge and emission quantity of hazardous compounds. HMM includes handling precautions, hazards and legal regulations with the databases provided by an outsourcing company (Figures 1-2).

Response to Arguments

11. Applicant's arguments filed 06/22/04 have been fully considered but they are not persuasive. First, the examiner did not quite understand the terminology used by the Applicants in their explanation of the essence of the invention i.e. "the present invention relates to a method in which the same group control ID (205, Pip 4) is given to a specified compound and the substances belonging to the specified compound for purposes of reporting the total discharged

amount of chemical substances generally called "xxxx compound" specified in the applicable law or regulation". It is not clear, how chemical substances can "belong" to the specified compound, when the words "compound" and "chemical substance" are synonyms? The lack of clarity in such explanation reflects in unclear language of the claims, since it is not apparent to the examiner, by which principle the controlled substances are grouped together and are issuing the same group control ID.

As for the arguments related to the rejection over the prior art: "Hazardous Materials Index" disclosed by Sturgeon fully corresponds to the controlled substances group control ID.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yelena G. Gakh, Ph.D. whose telephone number is (571) 272-1257. The examiner can normally be reached on 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yelena G. Gakh
8/23/04